

Remarks

I. Introduction

This is in response to the Office Action dated June 25, 2003 which reopened prosecution of the application in view of the Appeal Brief filed July 8, 2002. In view of the reopening of prosecution, Applicants choose to continue prosecution of this application before the Examiner by presenting this reply under 37 C.F.R. §1.111.

The Office Action indicated an Examiner's amendment, which Applicants have accepted and which amendment is reflected in the current claim listing. The Office Action rejected claims 1, 2, 5, 8, 9, 11, 22, 28 and 31-33 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,959,623 (van Hoff et al.). Claims 3, 35, 36 and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of U.S. Patent No. 5,715,314 (Payne et al.). Claims 4, 7 and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Taylor, *Creating Cobol[sic] Web Pages with HTML* (Taylor). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of U.S. Patent No. 5,970,469 (Scroggie et al.). Claims 10, 34 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of U.S. Patent No. 6,336,099 (Barnett et al.). Claims 13 and 18-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al. and further in view of U.S. Patent No. 6,483,895 (Bixler et al.). Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al. Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al., in view of Bixler et al. and further in view of Taylor. Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al. and further in view of Scroggie et al. Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al., in view of Bixler et al. and further in view of U.S. Patent No. 5,957,695 (Redford et al.). Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al., in view of Bixler et al. and further in view of Taylor. Claim 21 was rejected under 35

U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al., in view of Bixler et al. and further in view of Barnett et al. Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Payne et al., in view of Bixler et al. and further in view of Taylor. Claim 30 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Scroggie et al. Claims 12, 23-25, 48, 49, 51, 52, 54, 55, 57 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Bixler et al. Claim 50 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Bixler et al. and further in view of Taylor. Claim 59 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Bixler et al. and further in view of Barnett et al. Claim 60 was rejected under 35 U.S.C. §103(a) as being unpatentable over van Hoff et al. in view of Bixler et al. and further in view of Taylor.

In response, Applicants have amended claims 1, 4, 13, 14, 22, 27, 35, 41, 48 and 50. Claims 8, 9, 19, 20, 32 and 33 are cancelled by this amendment. Claims 1-7, 10-18, 21-31, 34-36, 41-42 and 48-60 remain for consideration.

II. The Currently Pending Claims are Allowable over the Cited Art.

The present invention is directed to a system and method for advertising and carrying out electronic commerce on the Web. The present invention takes advantage of advertising software that operates as an overlay to a conventional known browser, and divides the user's client computer display into an advertising area and a browser area. This configuration of software elements allows for certain advantages over the prior art. Such advantages, which are the subject of the claims as amended, are not shown nor suggested in the cited art. As such, allowance of all pending claims is respectfully requested.

The first advantage is the dynamic targeting of advertisements to a user's web browser. As described in the specification at page 18, lines 10 – 27 and page 25, line 17 – page 28, line 27, one advantage of the present invention is the ability to target specific advertisements to users based on the browsing habits of the user. Thus, the present invention advantageously provides the capability of selecting advertisements to show to

the user in the advertising area based upon the content of the pages viewed by the user in the browser area.

The second advantage is the ability to display further advertising information in the browser area when the user selects a link from the advertising area. As such, the selection of a link from the advertising area of the display causes information to be displayed in the browser area of the display. Thus, if a user, upon viewing an advertisement, wishes to see additional information about a product or service, the user may select a link and cause such additional information to be displayed in the browser display area.

These two aspects of the invention were the subject of dependent claims 8 (displaying information in browser when link from advertising area selected) and 9 (dynamic targeting of advertisements). The present amendment cancels dependent claims 8 and 9 and incorporates their limitations into independent claim 1. Independent claim 1 has been amended to contain the limitations of:

said advertising software adapted to receive an advertisement related to at least one page displayed to a user by said browser from said server,

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wherein an advertisement displayed to the user by said advertising software comprises at least one link that loads and displays a page in said browser area when said link is selected by a user.

As amended, claim 1 is patentable over the cited art. The Office Action had rejected claims 8 and 9 (which contained the subject matter now incorporated into claim 1 by the present amendment) as being anticipated by van Hoff et al. under 35 U.S.C. §102(e). In order for a reference to anticipate a claimed invention under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in the cited reference.

Applicants respectfully traverse the grounds for rejection and assert that claim 1 as amended is not anticipated by van Hoff et al. because van Hoff et al. does not disclose each and every limitation of the claims as amended.

With respect to the limitation relating to loading and displaying a page in the browser area when a link in the advertising area is selected by a user, the Office Action cited van Hoff et al. at col. 5, lines 1-14 as disclosing this aspect of the invention. However, the cited portion of van Hoff et al. merely indicates that additional information about an advertisement may be retrieved through a URL which is linked to a WWW site. However, in accordance with the disclosure of van Hoff et al., the additional information will be displayed in the advertisement window of the display, not in the browser window as currently claimed in the present invention. As disclosed by van Hoff et al. at col. 5, lines 1-14, the applets (310) perform the retrieval of the additional information. As described at col. 7, lines 25-30 of van Hoff et al., the applets are methods for displaying the information in the Ad list and the **Ad window**, as distinguished from the present invention in which the additional information selected by the user is displayed in the **browser area**.

With respect to the limitation related to the dynamic targeting of advertisements, the Office Action cited van Hoff et al. at col. 5, lines 1-14 as disclosing this aspect of the invention. As described above, the cited section of van Hoff et al. is directed to the retrieval of additional information related to particular subject matter. However, there is nothing in the cited section related to targeted advertising or to "advertising software adapted to receive an advertisement related to at least one page displayed to a user by said browser from said server" as claimed in claim 1.

All independent claims (i.e., claims 13, 22, 35, 41 and 48) have been amended to contain limitations similar to those added to claim 1. The following limitations (from dependent claims 19 and 20) have been added to independent claim 13:

wherein an advertisement displayed by said advertising software comprises at least one link that loads and displays a page in a browser area; and
wherein said server targets said advertisements to the user, said server transmitting advertisements related to pages displayed through said browser on said client's computer at the user's request.

Similarly, the following limitations have been added to independent claims 22 (incorporating the limitations of dependent claims 32 and 33), 35 and 41:

- b. determining the topics of pages viewed through said browser on said client computer at the user's request;
- c. selecting advertisements related to said topics;
- d. transmitting said advertisements related to said topics to said client computer from said server;
- .
- .
- .
- f. displaying an advertisement page in the browser area when the advertisement shown in the advertising area is selected by a user.

Similarly, independent claim 48 has been amended to contain the limitations of:

retrieve and display and targeted advertisement from an advertising server which selects advertisements based on topics of pages viewed through said browser software,

wherein said browser software and advertising software is further adapted to display an advertisement page by the browser when an advertisement displayed by said advertising software is selected by the user

All independent claims have been amended to contain limitations directed to 1) displaying information in the browser area when a link from the advertising area is selected and 2) dynamic targeting of advertisements. As described above, neither of these limitations is disclosed nor suggested in the cited art. Allowance of independent claims 13, 22, 35, 41 and 48 is requested.

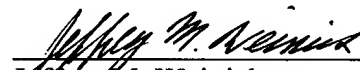
All remaining dependent claims depend upon, and incorporate the limitations of, one of the independent claims described above and are allowable for the reasons discussed above. Further, the dependent claims are further allowable due to the additional patentable subject matter claimed therein. For example, claims 4, 14, 27 and 50, as amended, are directed to the establishment of interactive communications between a user and a sales agent through the use of the advertising software. These dependent claims were rejected based on the disclosure of a feedback page in Taylor at page 219. The Applicants undersigned attorney has requested, but has not yet received, a copy of the relevant portions of the Taylor reference from the Examiner. Based on the Office

Action language, it seems that Taylor merely discloses a feedback button for submitting a page via a web form. The claims, as presently amended, are directed to interactive communication, rather than the mere submission of a form. This interactive communication is describe in the specification at least at page 19, line 14 – page 20, line 9. As such, these independent claims are allowable over the cited art and the amendments do not add any new matter to the claims.

III. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,



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